

The International Trademark Portfolio



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A Typical STOP Hotline Scenario

- I have just discovered that my product is being ripped off by a company in China.
- No, I am not marketing or manufacturing my products in China.
- I may (or may not) have U.S. patents and/or registered trademarks.
- No, I have not obtained (patents) (trademarks) in China related to my product that is being infringed.
- *WHAT IS MY RECOURSE? (And the corollary, Just what is the USG doing about all this?)*



A Typical STOP Hotline Scenario

And the answer is --



Life of a Trademark

I. CREATION

- Choosing a trademark or service mark

II. SCREENING and CLEARANCE

- Making sure the proposed mark is available

III. PROTECTION

- Seeking protection, country-by-country

IV. MAINTENANCE

- Renewing trademark registrations

Part I: LIFE OF A TRADEMARK



CREATION



Definition of a Trademark

U.S. Law

“Any word, name, symbol, or device, (or any combination thereof) used to identify and distinguish goods or services and to indicate their source.”

*Section 45 of the Trademark Act,
15 U.S.C. §1127*



Types of Trademarks

- Word Marks **KODAK**
- Design Marks
- Composite Marks containing both words and design
- Slogans



WE BRING GOOD THINGS TO LIFE



Some Unusual Trademarks

- Shape: Bottle shape for soda pop
- Color: Pink color for insulation
- Sound: Drums, trumpets and strings for entertainment / motion picture films
- Scent: Plumeria flower blossom scent for sewing thread
- Motion: Flying pegasus for movie studios



20thCenturyFox.mp3





Select Strong Trademarks!

In general, the more “**distinctive**” a mark is, the **stronger** it is and the **greater the scope of protection** the mark will receive in court against uses of the same or similar marks.

Because all trademarks do not receive or deserve the same scope of protection, the type of mark a business selects will have a direct effect on its ability to protect the mark.





Trademark Continuum



Source Indicating Capacity

No Source Identifying Capacity

Generic
soda

Not Inherently Distinctive but may acquire.

Merely Descriptive
COASTER-CARDS

Inherently Distinctive

Suggestive
VERICHECK

Arbitrary
APPLE

Fanciful
EXXON

Part II: LIFE OF A TRADEMARK



SCREENING and CLEARANCE



Types of Trademark Protection in the U.S.

- **Common Law** – unregistered; derived from use. “TM” “SM”
- **State Registration** – the “truly local.” Registered with one or more U.S. states
- **Federal Registration®** - interstate commerce or between the U.S. and another country.
- **Other Federal Statutes**
 - Smokey Bear
 - Woodsy Owl





SCREENING and CLEARANCE in the U.S.

- **USPTO DATABASE**
 - Federally registered trademarks and pending applications for registration
- **STATE TRADEMARK REGISTRIES**
- **DOMAIN NAME SEARCH**
 - Generic Top Level Domains (gTLDs)
 - Country Code Top Level Domains (ccTLDs)
- **COMMON LAW SEARCH**
 - the Web, trade names, trade directories, etc.

Obtaining a **“full search”** helps to ensure that these other sources of information will be considered in clearing trademarks.



SCREENING and CLEARANCE in Other Countries

- **IPO DATABASE**
 - Registered trademarks and pending applications for registration
- **DOMAIN NAME SEARCH**
 - Generic Top Level Domains (gTLDs)
 - Country Code Top Level Domains (ccTLDs)

PART III: LIFE OF A TRADEMARK



PROTECTION (Country-by-Country)



Does a Company Need to Register its Mark in the U.S.?

- Not required, because trademark rights (in the U.S.) arise from **use** on or in connection with goods or services, BUT...
 - There are significant **advantages** to having a federal trademark registration.



Advantages of Federal Registration on Principal Register

- **Public notice** of your claim of ownership of the mark;
- **A legal presumption of your ownership of the mark and your exclusive right to use the mark nationwide** on or in connection with the goods/services listed in the registration;
- The ability to bring an action concerning the mark in **federal court**;
- The use of the U.S. registration as **a basis to obtain registration in foreign countries**;
- The right to use the **federal registration symbol ®**;
- Listing in the United States Patent and Trademark Office's **online databases**; and
- Registration may be recorded with **U.S. Customs and Border Protection** to prevent importation of infringing foreign goods.
 - The recordation fee for trademarks is US\$190 per International Class of goods.



Is Federal Registration Valid Outside the United States?

- **No.**

Trademark rights are *territorial*: rights in particular trademarks exist only within the country whose laws granted those rights.



Does a Company Need to Register its Mark in Other Countries?

- USPTO Study of 1,000 US SMEs

Research conducted in the spring of 2005 by the USPTO indicates that only 15 percent of small businesses that do business overseas know that a U.S. patent or trademark provides protection only in the United States.



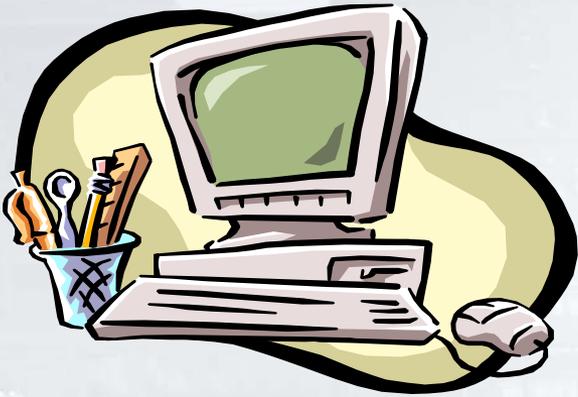
Registration in Other Countries – Why do it?

- **REGISTRATION IS REQUIRED IN ALMOST ALL OTHER COUNTRIES TO HAVE EFFECTIVE TRADEMARK RIGHTS.**
- **Public notice** of your claim of ownership of the mark;
- A **legal presumption of your ownership of the mark and your exclusive right to use the mark** on or in connection with the goods/services listed in the registration;
- The right to use a **registration symbol** (may be required in some countries);
- Listing in the Intellectual Property Office's **database**; and
- Registration may be recorded with the **local customs authority** to help stem exportation of infringing goods.



How Do I Get a Trademark Registration?

- Single application
- Regional application
- Madrid Protocol





How Many Applications?

Consider –

- English version
- Translation
- Transliteration



Legal Basis to File (U.S.)

What are the possible legal bases on which I can file an application to register a trademark in the United States?

- **Use** of the mark in commerce
 - bona fide use of a mark in the ordinary course of trade, and ***not*** made merely to reserve a right in a mark.
- A **bona fide intention** to use the mark in the future
 - Section 1(b) of the Trademark Act, 15 U.S.C. §1051(b), provides that an applicant may file an application based on a bona fide intention to use a mark in commerce “*under circumstances showing the good faith of such person.*”
- Foreign application or registration.



Legal Basis to File in Other Countries

What are the possible legal bases on which I can file an application to register a trademark in another country?



Examination Processes

- Absolute Grounds
- Relative Grounds
- Opposition and Cancellation Proceedings
- Appeal to Court



Protecting Trademarks Abroad

- Be proactive in protecting trademarks!
- Companies should consider registering their mark in countries in which:
 - Your goods or services are **marketed**;
 - Products or parts for your products are **manufactured**;
 - **Research and development facilities** are located;
 - Your products are **trans-shipped**;
 - You **might expand your business** in the future; or
 - **Counterfeiting** is likely to be a problem.

PART IV: LIFE OF A TRADEMARK



MAINTENANCE



Maintain Registrations!

- **In The U.S.**
 - Evidence of **continued use**: submitted between 5th and 6th year.
 - **Renewal**: submitted between 9th and 10th year.
 - Electronic forms can be completed very easily; much of the data is entered automatically.



Possible Loss of Rights

- Marking
- Recordation of licenses
- Failure to maintain registration
- Failure to use
- Failure to use proper form
- Failure to monitor



Resources for Assistance

- IPO Website
- WIPO Website
- STOPfakes.gov Website (Country Toolkits, China Webinars, IPR Training Tutorial,)
- Your U.S. Trademark Attorney



Thank You!

